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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,099

02/06/2004

Hung-Eil Kim

H1647

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01/26/2007

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EXAMINER

RUGGLES, JOHN S

ART UNIT

PAPER NUMBER

1756

MAIL DATE

DELIVERY MODE

01/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/774,099	Applicant(s) KIM, HUNG-EIL	
	Examiner John Ruggles	Art Unit 1756	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none.
- Claim(s) objected to: none.
- Claim(s) rejected: 1-15.
- Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE: The proposed amendments to the specification and the claims while partially addressing issues set forth in the previous 11/13/06 final Office action would nevertheless still require further consideration and revision of the previous objections and rejections. For example, the currently proposed amendment to the abstract would delete essential information about the reason for locating a critical dimension (CD) test pattern on the peripheral region of the mask substrate outside the region covered by the pellicle so that the pellicle does not have to be removed to measure the mask CD. In response to the previous objection to the specification numbered (2), Applicant's argument on page 8 of 12 in the currently proposed amendment still leaves doubt about whether or not the pellicle having a thin polymer film stretched across a frame attached to the mask referred to in the specification at page 1 line 20 is at all related to the pellicle mounted on the SAME mask in the previous line 19. Applicant's proposed amendment to the specification paragraph beginning at page 3 line 11 is also not sufficient to overcome the previous specification objection numbered (4). The proposed amended claims have also not fully addressed all of the previous detailed reasons for rejection of the claims under the second paragraph of 35 USC 112 (see pages 4-5 of the 11/13/06 Office action). For instance, in the currently proposed claim amendment it is still unclear FROM what source the first pattern and the at least one test pattern are projected onto the substrate in claim 1 lines 3-4 (as well as throughout other applicable claims). Also in claim 6, the extent or degree of similarity between the conditions under which the first pattern and those under which the at least one test pattern are formed on the photomask are still unclear. Therefore, the currently proposed amendments will not be entered.

Continuation of 11. does NOT place the application in condition for allowance because: the proposed amendments to the specification and the claims while partially addressing issues set forth in the previous 11/13/06 final Office action would nevertheless still require further consideration and revision of the previous objections and rejections, as indicated above. Therefore, the currently proposed amendments will not be entered.

In the remarks on page 9 of 12 in the currently proposed amendment regarding the previous rejection of claim 5 under the second paragraph of 35 USC 112, Applicant refers back to the previous argument on page 7 of 10 in the 8/31/06 amendment. In that earlier instance, Applicant made a broad statement that one of ordinary skill in the art would somehow have understood the meaning of "substantially simultaneously" in claim 5 and made reference to MPEP 2173.05(b), but Applicant entirely fails to even hint at just what this meaning would be. In fact, Applicant was previously informed of the examiner's specific interpretation of this language to mean "at the same time" (see page 4 of the 7/28/06 Office action and pages 4-5 of the 11/13/06 Office action), but Applicant has now failed twice to even indicate whether or not Applicant agrees with this interpretation. It is not the examiner who has failed to be forthcoming on this issue, but rather it is the Applicant who has failed to clarify the record. Furthermore, this section of the MPEP clearly states, in part, "While, as a general proposition, broadening modifiers are standard tools in claim drafting in order to avoid reliance on the doctrine of equivalents in infringement actions, when the scope of the claim is unclear a rejection under 35 U.S.C. 112, second paragraph, is proper. See *In re Wiggins*, 488 F. 2d 538, 541, 179 USPQ 421, 423 (CCPA 1973)." Applicant has been informed of at least two different reasonable interpretations for the above language in claim 5 showing that this language is unclear, so the previous rejection of this claim under the second paragraph of 35 USC 112 is still believed to be proper.

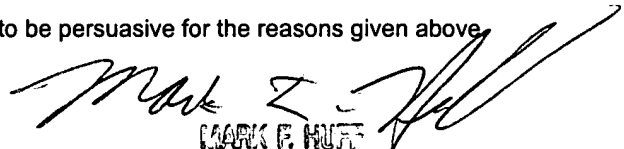
In regard to the arguments on pages 9-11 against the previous art rejections of the instant claims under 35 USC 103, the reasons for moving the CD monitor pattern of Tanaka et al. outside the pellicle on the mask substrate are because (a) it would have been an obvious design choice to locate the CD monitor pattern along with most of the other testing patterns (outside the pellicle) and (b) these testing patterns, including the CD monitor pattern, are all made of the same attenuating material that would be reasonably expected to be suitable for use under the same or similar conditions, which suggests that the CD monitor pattern would also be suitable for unprotected placement outside of the pellicle (just like the other testing patterns that are unprotected outside of the pellicle). In addition, placement of the CD monitor pattern outside the pellicle on the mask would result in the same advantages that are known to those of ordinary skill in the art for locating other testing patterns of the same material outside the pellicle as taught by Tanaka et al. (e.g., the same testing equipment can be used for all of the testing patterns (including the CD monitor) outside the pellicle without impinging on the pellicle, to avoid causing pellicle damage or distortion in the measurement of the CD monitor pattern if the the CD pattern were located underneath the pellicle, etc.).

In response to Applicant's argument on page 11 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to Applicant's argument on page 11 that there is no suggestion or motivation to change or combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reasons for modifying and combining the prior art reference(s) were previously stated and are further discussed above.

Applicants current arguments have been fully considered, but they are still not found to be persuasive for the reasons given above.

jsr
571-272-1390



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